

REMARKS

Claims 1 through 22 are pending in the application.

Claims 1, 7 and 12 have been amended.

Examiner has rejected claims 1, 2, 6, 7, 9, 10, 12, 13, 17, 18 and 20 through 22 under 35 U.S.C. § 102(b) as being anticipated by USPN 5,630,103 (Smith).

Examiner has rejected claims 1, 3 through 7, 12, 14 through 16 and 20 under 35 U.S.C. § 102(b) as being anticipated by USPN 6,591,068 (Dietz).

Examiner has rejected claims 8, 11 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of USPN 6,209,103 (Aisenberg).

Applicant has variously amended the claims. Applicant respectfully traverses the rejection of the claims as amended.

Response to New Arguments Raised by Examiner

CLAIM 1 (SMITH)

Monitoring activity level

Examiner has argued as follows:

In response to applicant's arguments regarding the rejection of claim 1 to Smith et al., whereby applicant argues on pages 11 and 12, that Smith fails to teach of a response system that monitors activity level around a physical location of a publication delivery system. As read in column 7, lines 25-40, Smith states that "The receiving computer 48 monitors its connection to the FM subcarrier receiver 47 until it begins receiving the data stream. It then monitors the incoming data stream until it detects the synchronization sequence." Thus the FM sub carrier receiver 47 can be interpreted as monitoring the activity level around the physical location of the publication delivery system 45, seen in Fig. 1.

Examiner's argument is based on a non sequitur. Examiner cites a section of Smith that indicates **receiving computer 48** monitors a connection to FM subcarrier receiver 47. On the basis of this monitoring by **receiving computer 48**, Examiner asserts that FM sub carrier receiver 47 can be interpreted as monitoring the activity level around the physical location of the publication delivery system 45. This is a non sequitur.

Applicant notes that the section of Smith cited by Examiner indicates monitoring done by receiving computer 48. Specifically, receiving computer 48 monitors a data stream from FM subcarrier receiver 47. The section of Smith cited by Examiner does not disclose or suggest that FM subcarrier receiver 47 (or receiving computer 48) monitors activity level around a physical location of publication delivery system 45.

Timing and number of printed publications printed by the printing mechanism are based on the activity level detected by the response system

Examiner has argued as follows:

Continuing, applicant argues on page 12, that Smith fails to disclose that timing and number of printed publications printed by the printing mechanism are based on the activity level detected by a response system. As discussed above, Smith teaches that the activity level of the data signals is monitored by the FM subcarrier receiver 47, as read in column 7, lines 34-57. With this, Smith teaches that timing of the publications and the number of printed publications is based on the detected activity level, as read in column 5, lines 24-46, and column 7, line 41 - column 8, line 65. Particularly, in column 8, lines 27-33. Smith teaches that the timing of the publications is based on the monitored level of activity, wherein the "receiver checks the data stream to ensure that it receives the end of data block and synchronization sequences. If it does it restarts the receive process. Otherwise, it again begins monitoring the data stream for the synchronization sequence." Further in column 5, lines 24-46, Smith

teaches that the number of printed publications is based on the monitored activity level, wherein "the visible copy 46 reproduced from files extracted from the data flow stream received at the radio receiver unit 47 and stored in the computer 48 for reproduction upon a viewing screen or printer."

Examiner has cited various sections of Smith that discuss Figure 5. As is clear from Figure 5, and the text within Smith that describes Figure 5, Smith is here discussing receipt of a data file. In these cited sections of Smith no mention or discussion is made of printing a publication, of monitoring activity level around a physical location of a publication delivery system, nor of the timing and number of printed publications printed by the printing mechanism are based on the activity level detected by the response system.

Examiner also cites column 5, lines 24 through 46 where Smith indicates visible copy 46 is stored in computer 48 for reproduction upon a viewing screen or printer. However, nowhere does Smith indicate that the timing or number of printed publications is based on an activity level detected by a response system.

CLAIM 9 (SMITH)

Examiner has argued as follows:

In response to applicant's arguments regarding the rejection of claim 9 to Smith et al., whereby applicant argues on pages 14 and 15, that Smith fails to teach of checking a time stamp on a most recently printed publication stored in a storage area. Further applicant argues that Smith fails to teach of determining whether a fresher version of the printed publication is electronically available. As read in column 5, lines 34-40, Smith teaches that the "subscriber station representation 45 "reproducing visually the newspaper copy 15 being transmitted into the visible copy 46 reproduced from files extracted from the data flow stream received at the radio receiver unit 47 and stored in the computer 48 for reproduction upon a

viewing screen or printer." Thus, the visible copy 46, as seen in Fig. 1, is printed by the printer, being extracted from the received data stream, so as to be viewed by the subscriber, as well as being stored in the computer. With this, Smith further teaches in column 7, line 58 - column 8, line 26 that "the receiving software compares the received date with the date of the file already stored on the receiving computer 48". This comparison is used to determine whether a fresher version of the publication is available, as read in column 8, lines 58-62.

In this discussion, Examiner ignores several limitations set out in claim 9 that are not disclosed or suggested by Smith. For example, claim 9 indicates the checking of the time stamp is in response to a customer ordering a publication. In Smith, the date of a file is checked upon a new file being received.

Likewise, in claim 9, a time stamp on a most recently printed publication stored in a storage area is checked. In Smith there is no mention of storage of a recently printed publication in a storage area.

The criteria for a rejection under 35 U.S.C. § 102 include the following: "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Examiner has failed to meet this criterion.

Examiner has additionally argued as follows:

Continuing, applicant argues on pages 15 and 16 that Smith fails to teach of seeking or receiving from a customer an indication that the customer is willing to wait for a fresher version of a printed publication to be printed out for delivery. As read in column 5, lines 40-46, Smith teaches that "those portions of the original copy 15 that the subscriber wants may be selected for storage and viewing (46) in the subscriber's computer system 48, which has a corresponding local software for interactively selecting and storing those files of the subscriber's choice." Further, in column 8, lines 49-65, Smith teaches that "when newspapers from past days are stored, it is a requirement of the viewer software that it be able to distinguish by means of data files in the database between different sets of data

streams. In this preferred embodiment the structure, content and nature of the relationship between files is established for the viewing software by data files transmitted". Thus, a user can select, using the viewing software, whether they would want a version stored in the memory of the computer. If there is no selection, the system inherently receives an indication that the customer is willing to wait for a fresher version.

In this discussion, Examiner ignores several limitations set out in claim 9 that are not disclosed or suggested by Smith. For example, step (a.3) of claim 9 indicates that when in (a.2) it is determined that a fresher version of the printed publication is not electronically available, the most recently printed publication stored in the storage area is delivered to the customer. Smith makes no mention of storage of a storage area from which a most recently printed publication can be delivered to a customer.

Examiner has therefore failed to meet the criteria for a rejection under 35 U.S.C. § 102 that requires that the identical invention must be shown in as complete detail as is contained in the claim.

Criteria for rejection of claims under 35 U.S.C. § 102 and 35 U.S.C. § 103

The criteria for a rejection under 35 U.S.C. § 102(b) has been clearly defined by the courts and confirmed by the U.S. Patent and Trademark Office. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the

... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In order to establish a *prima facie* case of obviousness, the prior art references when combined must teach or suggest all the claim limitations.

Below, Applicant points out subject matter within each independent claim that is not disclosed or suggested by the cited art, whether considered alone or in combination. On the basis of this, Applicant believes all the claims are patentable over the cited art.

Discussion of Independent Claim 1

Claim 1 sets out a publication delivery system. A printing mechanism prints copies of a publication. A response system monitors activity level around a physical location of the publication delivery system in order to detect proximity of potential customers. The timing and number of copies of the publication printed by the printing mechanism are based on the activity level detected by the response system.

Claim 1 is not disclosed or suggested by the cited art.

Smith:

Smith discloses radio transmission for distribution of newspaper copy in computer format to personal computers for viewing.

Smith does not disclose or suggest a response system that monitors activity level around a physical location of the publication delivery system in

order to detect proximity of potential customers, as set out in claim 1.

Specifically, receiver 47, shown in Figure 1 of Smith, does not disclose or suggest monitoring activity level around a physical location of the publication delivery system in order to detect proximity of potential customers.

Likewise, claim 1 states that timing and number of copies of the publication printed by the printing mechanism are based on the activity level detected by the response system. This is not disclosed or suggested by Smith.

Dietz:

Dietz discloses a method and apparatus for automatic image capture. In Dietz, pictures are automatically taken of guests in theme part. The pictures are made available to the guests.

Dietz does not disclose or suggest that a number of copies of a publication printed by the printing mechanism is based on an activity level detected by a response system. Further, Dietz does not disclose that an increased detected activity level, results in an increased number of copies of the publication being printed.

While it is conceivable in Dietz that a guest could request multiple copies of a picture, nowhere does Dietz disclose or suggest that a number of copies of a publication printed by a printing mechanism is based on an activity level detected by a response system.

Discussion of Independent Claim 9

Claim 9 sets out a method for distributing a publication by an automated kiosk. In response to a customer ordering a publication, a time stamp on a most recently printed publication stored in a storage area is checked and it is determined whether a fresher version of the printed publication is electronically available. When it is determined that a fresher version of the printed publication is not electronically available, the most recently printed publication stored in the storage area is delivered to the customer. When it is determined that a fresher version of the printed publication is electronically available and the customer indicates a willingness to wait for printing, the fresher version of the printed publication is obtained and printed out for delivery to the customer. None of this subject matter is disclosed or suggested by the cited references.

Smith:

Examiner has asserted that Smith, at column 6, lines 48 through 67 and column 7, line 47 through column 8, line 26 discloses a time stamp on a most recently printed publication stored in a storage area. This is incorrect. At column 6, lines 48 through 67 and column 7, line 47 through column 8, line 26, Smith is discussing details of transferring a data stream to a receiving computer.

In Smith, the receiving computer 48 receives a date and time that a file was created and ensures that the received timestamp represents a valid date. See column 7, lines 55 through 57. The received date is compared with the date

of the file already stored on the receiving computer 48. See column 7, lines 58 through 60. However, Smith never checks a time stamp on *a most recently printed* publication stored in a storage area. Particularly, in Smith, the date of a file is checked. Smith does not disclose suggest checking the time stamp on a *printed* publication stored in a storage area. Smith does not even mention a storage area for printed publications.

Examiner has asserted that Smith at column 7, lines 47 through column 8, line 26, discloses determining whether a fresher version of the printed publication is electronically available. This is incorrect. At column 7, line 47 through column 8, line 26, Smith is discussing details of transferring a data stream to a receiving computer.

In Smith, a stored file is not overwritten when the stored file date is the same or later than the received file date. See column 7, lines 70 through 62. However, Smith does not disclose or suggest checking a time stamp *on a most recently printed* publication stored in a storage area. Particularly, in Smith, the date of a *file* is checked. Smith does not disclose suggest determining whether a fresher version of a *printed* publication is electronically available.

Examiner has asserted that Smith at column 5, lines 11 through 65 and column 7, line 52 through column 8, line 65 and Figures 6A and 6B, discloses that when it is determined that a fresher version of the printed publication is electronically available and the customer indicates a willingness to wait for printing, the fresher version of the printed publication is obtained and printed

out for delivery to the customer. This is incorrect. At column 5, lines 11 through 65 and column 7, line 52 through column 8, line 65 and Figures 6A and 6B, Smith is discussing details of transferring a data stream to a receiving computer. Smith does not disclose or suggest seeking or receiving from a customer an indication that the customer is willing to wait for a fresher version of a printed publication to be printed out for delivery.

Discussion of Independent Claim 12

Claim 12 sets out a method for distributing a publication by an automated publication delivery system. Activity level around a physical location of the publication delivery system is monitored in order to detect proximity of potential customers. In response to detection of an increased activity level around the physical location of the automated publication delivery system, additional copies of the publication are printed for distribution.

Claim 1 is not disclosed or suggested by the cited art.

Smith:

Smith discloses radio transmission for distribution of newspaper copy in computer format to personal computers for viewing.

Smith does not disclose or suggest monitoring activity level around a physical location of the publication delivery system in order to detect proximity of potential customers, as set out in claim 12. Specifically, receiver 47, shown in

Figure 1 of Smith, does not disclose or suggest monitoring activity level around a physical location of the publication delivery system in order to detect proximity of potential customers.

Likewise, claim 12 states that in response to detection of an increased activity level around the physical location of the automated publication delivery system, additional copies of the publication are printed for distribution. This is not disclosed or suggested by Smith.

Dietz:

Dietz discloses a method and apparatus for automatic image capture. In Dietz, pictures are automatically taken of guests in theme part. The pictures are made available to the guests.

Dietz does not disclose or suggest that in response to detection of an increased activity level around the physical location of the automated publication delivery system, additional copies of a publication are printed for distribution.

While it is conceivable in Dietz that a guest could request multiple copies of a picture, nowhere does Dietz disclose or suggest that a number of copies of a publication printed by a printing mechanism is based on an activity level detected by a response system.

Discussion of Independent Claim 21

Claim 21 sets out a printing mechanism for printing a publication.

Response System:

In Claim 21, a response system monitors activity around a physical location of the publication delivery system. This is not disclosed or suggested by the cited art.

Examiner has asserted that Smith, at column 8, line 66 through column 9, line 11, discloses a response system that monitors activity around a physical location of a publication delivery system. This is incorrect. At column 8, line 66 through column 9, line 11, Smith discloses a receiving computer that is equipped with a graphic user interface. A user is permitted to interact with the computer using full screen icons and pictures, typically controlling the computer activities with pointing devices such as computer mice. Smith does not disclose or suggest a response system that monitors activity level around a physical location of a publication delivery system.

Timing and Number of Printed Publications:

Claim 21 sets out that timing and number of printed publications printed by the printing mechanism is based on the activity detected by the response system. This is not disclosed or suggested by the cited art.

Examiner has asserted that Smith at column 5, lines 24 through 65 and column 7, lines 14 through column 9, line 11 discloses that timing and number of printed publications printed by a printing mechanism are based on the activity

detected by a response system. This is incorrect. In Smith's system data files are sent to a receiving subscriber's computer 48 for reproduction upon a viewer screen or printer. See column 5, lines 33 through 40. A user controls receiving computer using a graphics user interface. See column 8, line 66 through column 9, line 3. Nothing in Smith discloses or suggests that timing and number of printed publications printed by a printing mechanism are based on the activity level detected by a response system. As discussed above, Smith does not even disclose or suggest a response system that monitors activity level around a physical location of a publication delivery system.

Time Stamp Reader:

In claim 21, a time stamp reader reads a time stamp on a most recently printed publication stored in the storage area. The print delivery system uses the time stamp to determine freshness of the most recently printed publication stored in the storage area. This is not disclosed or suggested by the cited art.

Examiner has asserted that Smith, at column 6, lines 48 through 67 and column 7, line 47 through column 8, line 26 discloses a time stamp reader that reads a time stamp on a most recently printed publication stored in the storage area. This is incorrect. At column 6, lines 48 through 67 and column 7, line 47 through column 8, line 26, Smith is discussing details of transferring a data stream to a receiving computer.

In Smith, the receiving computer 48 receives a date and time that a file was created and ensures that the received timestamp represents a valid date. See column 7, lines 55 through 57. The received date is compared with the date of the file already stored on the receiving computer 48. See column 7, lines 58 through 60. However, Smith never checks a time stamp *on a most recently printed publication* stored in a storage area. Particularly, in Smith, the date of a file is checked. Smith does not disclose suggest checking the time stamp on a *printed* publication stored in a storage area. Smith does not even disclose a storage area for storing a printed publication.

Examiner has asserted that Smith at column 7, lines 47 through column 8, line 26, discloses determining whether a fresher version of the printed publication is electronically available. This is incorrect. At column 7, line 47 through column 8, line 26, Smith is discussing details of transferring a data stream to a receiving computer.

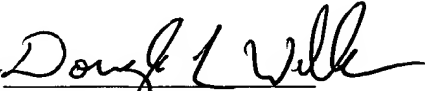
In Smith, a stored file is not overwritten when the stored file date is the same or later than the received file date. See column 7, lines 70 through 62. However, Smith does not disclose or suggest checking a time stamp *on a most recently printed publication* stored in a storage area. Particularly, in Smith, the date of a *file* is checked. Smith does not disclose suggest determining whether a fresher version of a *printed* publication is electronically available.

Conclusion

Applicant believes this Amendment has placed the present case in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,

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August 16, 2005
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